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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,027	08/16/2001	Tomoyasu Nakamura	212353US0PCT	1232

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21  
EXAMINER

WONG, LESLIE A


ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/926,027</b>	Applicant(s) <b>Nakamura et al.</b>	
	Examiner <b>Leslie Wong</b>	Art Unit <b>1761</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on May 23, 2003
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 13, and 17-33 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 13, and 17-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant does not clearly teach what is encompassed by "a material lacking a bitter flavor."

Applicant's arguments filed May 23, 2003 have been fully considered but they are not persuasive.

Applicant argues that the exclusion of bitterness is supported by the specification, and that "lacking a bitter flavor" would be well-known to one of skill in the art.

In view of Applicant's specification it is not clear what Applicant intends to claim. For example, on page 1, third paragraph of the specification Applicant states that soy protein/milk is disliked for bitterness. Yet Applicant claims both soy milk and foods containing soy protein and also excludes foods having a bitter flavor. Soy products do not lack a bitter flavor.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 13, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujisaka Takaaki (JP 63167786) and Kubota et al (US Patent No. 4897272).

Fujisaka Takaaki teach a vinegar blend which uses gluconic acid lactone to reduce smell and acidity (see abstract).

Kubota et al teach adding gluconic acid to vinegar (see entire document, especially column 6, lines 24-26, and claim 1).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, and 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudas et al, Cumberland Packing Corp, Catania (EP 0582396), Yusuke (JP 61120690), Fujisaka Takaaki (JP 63167786), Kingsley et al (WO 88/06004), and Kubota et al (US Patent No. 4897272).

Gudas et al disclose the use of sodium gluconate in chewing gum (see entire document).

Cumberland Packing Corp discloses the use of sodium gluconate in food products (see entire document).

Catania et al disclose the addition of a salt of gluconic acid to an ingestible product (see

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entire document, especially page 4, lines 16-24).

Yusuke discloses the addition of gluconate to water (see abstract).

Fujisaka Takaaki disclose a vinegar blend which uses gluconic acid lactone to reduce smell and acidity (see abstract).

Kingsley et al disclose using gluconic acid and its salt to improve the organoleptic properties of seafood (see entire document, especially page 4, first full paragraph).

Kubota et al disclose adding gluconic acid to vinegar (see entire document, especially column 6, lines 24-26, and claim 1).

The claims differ as to the recitation of a flavor other than bitter and the specific foods.

All of the cited references contain flavors other than "bitter" as obvious components. That is, all of the food products contain other flavors such as "astringency, pungency, and sourness" as described by Applicant on page 5 of the specification.

All of the prior art teaches the use of nontoxic salts of gluconic acid as a taste modifier.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to add a nontoxic salt of gluconic acid as taught by Gudas et al, Cumberland Packing Corp, Catania, and Yusuke to any orally ingestible product because the use of gluconic acid salts to improve flavor is conventional in the art and the salt is used for no more than its art-recognized function.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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It is noted in response to Applicant's arguments filed May 23, 2003 that the observation of another beneficial result in an old process cannot form the basis of patentability, see *In re Jones* 1941 CD 686.

In the absence of unexpected results, it is not seen how the claimed invention differs from the teachings of the prior art. Applicant's claims are drawn to a combination of known components which produces expected results, see *In re Kerkhoven* 205 USPQ 1069 and *In re Gershon* 152 USPQ 602.

All of the claim limitations and arguments have been considered. None of them are seen as serving as basis for patentability. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Friday. The fax number for this Group is (703) 872-9310 for non-final responses and (703) 872-9311 for after-final response. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
August 1, 2003